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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/633,143

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Thomas F. Doyle

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EXAMINER

HAYLES, ASHFORD S

ART UNIT

PAPER NUMBER

3687

NOTIFICATION DATE

DELIVERY MODE

11/12/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/633,143	Applicant(s) DOYLE ET AL.	
	Examiner ASHFORD HAYLES	Art Unit 3687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Amendment received on August 14, 2009 has been acknowledged. Claims 1-25 have not been amended. Therefore, claims 1-25 are currently pending.

Response to Amendments

Affidavit-37 CFR 1.131

2. The declaration filed on August 14, 2009 under 37 CFR 1.131 has been considered but is ineffective to overcome the Prange reference.
3. The evidence submitted is insufficient to establish diligence from a date prior to the date of reduction to practice of the Prange reference to either a constructive reduction to practice or an actual reduction to practice.

Evidence, Exhibit I and II are relied upon to show a written disclosure documenting the conception of the invention. The submitted Exhibits I and II both disclose a brief description of a system that allows a cellular phone user to call into an access server that has the abilities of a credit/debit system and gives the cellular phone user the opportunity to place a personal call by using a personal credit or debit account. Applicant has elected to redact dates of submitted evidence; however, the actual dates of acts relied on to establish diligence must be provided. *See MPEP 715.07(a)*.

Where conception occurs prior to the date of the reference, but reduction to practice is afterward, it is not enough merely to allege that applicant or patent owner had been diligent. *Ex parte Hunter*, 1889 C.D. 218, 49 O.G. 733 (Comm'r Pat. 1889). Rather, applicant must show evidence of facts establishing diligence. In determining

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the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. Ex parte Kantor, 177 USPQ 455 (Bd. App. 1958). Applicant is lacking sufficient evidence of facts establishing diligence, therefore the applied 35 USC 103 (a) Prange primary reference stands.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3, 6-7, 9-13, 16, 18-21 and 24 are rejected under 35

U.S.C. 103(a) as being unpatentable by Prange (2005/0086138).

As per Claims 1, 10 and 18, Prange discloses an apparatus for providing separable billing services (Figure 1, Billing Calculation Center 8), comprising:

a memory for storing an identifier, the identifier identifying a digital processing device connected to a data network, the identifier further assigned a communication type (pg.1, ¶ [0011] discusses standard information: identity of the subscriber identity module in the mobile radio terminal 3, duration of the call, tariff, roaming charge, etc., details of the service-related or private nature of the current or most recently made call

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are also stored in a list billing record for this subscriber 1 or for his subscriber identity module, in the billing calculation server 8); and

a processor for receiving a data packet, the data packet comprising an address, the processor for comparing the address to the identifier and for adjusting an account associated with the communication type if the address matches the identifier (pg.1, ¶ [0011] A message representing the service-related or private nature of the current or most recently made call can be sent by the mobile radio terminal 3 as a short message SMS, MMS, etc., USSD or in another manner to an address (for example a short message center 7) of the mobile radio network 5,6, from where it is forwarded to a billing calculation server 8 of the mobile radio network to enable the monthly charges to be calculated).

Therefore Prange discloses the claimed apparatus except for a memory and a processor. Prange discloses that it is known in the art to provide a bill calculation server. Examiner takes Official Notice that it would have been well known within the art for a server to comprise a memory and a processor. Therefore, it would have been obvious for one having ordinary skill in the art at the time the invention was made to provide the bill calculation server of Prange with a memory storing unit for storing identifiers and a processing unit to process data packets of, in order to separate invoicing of private and service-related conversations on mobile telephones.

As per Claims 2, 13 and 21 Prange discloses the apparatus of Claim 1, further comprising an interface for routing said data packet to a destination associated with the address (Figure 1, depicts Short Message Center 7 interfaced with Billing Calculation 8).

As per Claims 3, 11 and 19 Prange discloses the apparatus of Claim 1, wherein the communication type comprises a business-type communication (pg.1, ¶ [0011] discusses service related call).

As per Claims 6, 16 and 24 the apparatus of Claim 1, wherein the processor further comprising a second account, the second account associated with a second type of communication, if the address does not match the identifier (pg.1-2, ¶ [0011] discloses charge information is split in accordance with the information stored on the service-related or private nature and produces two part-invoices for service-related and private calls for the invoice for the mobile radio subscriber 1. In this case the basic subscription charge can also for example be split pro-rata or equally).

As per Claims 7, 12 and 20 the apparatus of Claim 6, wherein the second type of communication comprises a personal-type communication (pg.1, ¶ [0011] discloses private nature calls).

The Examiner notes for examination purposes, the Examiner will take the broadest reasonable interpretation of the above underlined portion of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps in the claims are satisfied, the method as a whole is satisfied -- regardless

of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

6. Claims 4-5, 8, 14-15, 17, 22-23 and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Prange (2005/0086138) in view of Kelley (2002/0042715).

As per Claims 4-5, 14-15 and 22-23 Prange discloses the apparatus of Claim 1. However, Prange fails to disclose wherein the address comprises a destination and source address.

Kelley discloses wherein the address comprises a destination and source address (Figure 3, Separation process depicts Destination Phone number or URI and Originating Phone number, TCP/IP address, username or other mobile device owner-identifying attribute).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the separate invoicing of private and service-related conversations of Prange to include the destination and originating phone numbers as taught by Kelley in order to delineate responsibility for payment of billings due to use of communication devices (Abstract).

As per Claims 8, 17 and 25 Prange discloses the apparatus of Claim 1. However, Prange fails to disclose *wherein the data packet is not forwarded to the digital processing device if the address does not match the identifier.*

Kelley discloses wherein the data packet is not forwarded to the digital processing device if the address does not match the identifier (pg.2, ¶ [0031] discusses Keypad Separation; after completing a service transaction (e.g. a voice or data call or browsing to a URI), or before completing said transaction, which is based on the features and capabilities of the mobile device being used, the user enters one or more pre-designated keys (e.g. pressing `1` for personal or `2` for business). These additional keys are recorded by the carrier (=Service provider) and are included in the CDRS. During the separation process calls are identified as employer or employee calls by looking up the entered key and comparing it to what the employer had specified as codes indicating either business or personal transactions).

Therefore, it would have been obvious to one of ordinary skill in the art to modify the separate invoicing of private and service-related conversations of Prange to include the ability to filter calls that match stored identifiers as taught by Kelley in order to delineate responsibility for payment of billings due to use of communication devices (Abstract).

The Examiner notes the emphasized portion of the above claim recite a negative limitation, which define the invention in terms of what it was not, rather than pointing out the invention, therefore the emphasized portion will be given little patentable weight. Also for examination purposes, the Examiner will take the broadest reasonable interpretation of the above underlined portion of the claims. Since the "if" statement is conditional and not necessarily performed, once the positively recited steps

in the claims are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Response to Arguments

7. Applicant's arguments filed August 14, 2009 have been fully considered but they are not persuasive.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ASHFORD HAYLES whose telephone number is (571)270-5106. The examiner can normally be reached on Monday - Friday 8:00 A.M.- 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art
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/A. H./
Examiner, Art Unit 3687